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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,820	03/04/2004	Naoto Watanabe	03500.017940	3654

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

BEAUCHAINE, MARK J

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/791,820	Applicant(s) WATANABE ET AL.	
	Examiner Mark J. Beauchaine	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/25/07 & 9/28/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt of the Applicant's amendment dated 25 September 2007 and supplemental amendment dated 28 September 2007 that are in response to final Office action dated 26 June 2007 is acknowledged. After further consideration, claims 1-6, 16 and 17 pending in the instant application are subject to new grounds of rejection. Accordingly, finality of said final Office action is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Number US 6,494,453 B1 by Yamada et al ("Yamada") in view of Patent Number 6,146,085 by Namba et al ("Namba"). The sheet stacking apparatus disclosed by Yamada comprises a first tray 1 on which sheets discharged from outlet E2 are stacked (see Figures 1 and 2), said first tray being movable between a stacking position at which the sheets discharged from the outlet are stacked and a first retracted position above the stacking position. Yamada further discloses second tray 2 on which sheets discharged from the outlet are stacked, said second tray being

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disposed below said first tray being movable between a stacking position at which the sheets discharged from the outlet are stacked when said first tray is at a first retracted position, and a second retracted position below the stacking position (column 14, lines 50-61).

Still further, Yamada discloses controller 102 that controls movement of said first tray and said second tray independently of each other, wherein when the sheets are to be stacked on said first tray, said controller stops descending movement of said second tray when a moving distance of said second tray reaches a predetermined distance, *i.e.*, the distance from sensor SN8 to outlet E2, (column 9, lines 26-33) which is set so that the top surface of the sheets stacked on said second tray does not interfere with said first tray which is at the stacking position. Sensor SN8 detects the sheets on said second tray wherein the predetermined distance is set to a distance of movement up to just before an output of said sensor changes from "sheet present" to "sheet absent".

After the moving distance of said second tray reaches the predetermined distance, said controller initiates an ascending movement of said second tray in response to a change of output of said sensor from "sheet present" to "sheet absent," and stops the ascending movement in response to a change of the output of said sensor from "sheet absent" to "sheet present" (column 16, lines 59-64).

When the moving distance of said second tray reaches the predetermined distance, said controller stops said second tray regardless of the output of said sensor (column 18, lines 47-59). Yamada further discloses second sensor SN9 that detects that said second tray has descended to reach a lower limit when the sheets are to be

stacked onto said first tray (column 18, lines 32-46). When the moving distance of said second tray reaches the predetermined distance, said second tray is above the second retracted position.

Yamada fails to disclose said second tray descending distance as being constant. Namba teaches a second tray 9B that descends to a retracted position at a predetermined constant distance below a discharge outlet (see Figure 5; column 7, lines 48-53; column 13, lines 10-18; column 15, lines 29-36) for the purpose of ensuring that said second tray attains said retracted position at a preset time period. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the second tray configuration of Namba into the sheet stacking apparatus of Yamada for the purpose of ensuring that said second tray attains said retracted position at a preset period of time.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada in view of Namba as applied to claim 2 above, and further in view of Patent Number 5,228,679 by Borostyan ("Borostyan"). Yamada fails to disclose an ascending movement of second tray 2 before the moving distance of said second tray reaches the predetermined distance. Borostyan teaches a sheet stacking apparatus comprising controller 96 and tray 114 that contains a stack of sheets. Controller 96 initiates an ascending movement of tray 114 before the moving distance of said tray reaches a predetermined distance (column 7, lines 55-69) for the purpose of stationing the upper surface of the stack of sheets at a predetermined location. It would have been obvious

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to one of ordinary skill in the art at the time the invention was made to incorporate the ascending operation of Borostyan into the sheet stacking apparatus of Yamada for the purpose of stationing the upper surface of a stack of sheets at a predetermined location.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6, 16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjb



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